

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 06028.0033
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>		
Application Number 10/721,106		Filed November 26, 2003
First Named Inventor Gabin Vic		
Art Unit 1619		Examiner VENKAT, Jyothsna A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- applicant/inventor.
 - assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
 - attorney or agent of record.
Registration number 52,211
 - attorney or agent acting under 37 CFR 1.34.
- Registration number if acting under 37 CFR 1.34 _____



Signature

Deborah M. Herzfeld
Typed or printed name

202-408-4388

Telephone number

September 4, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action dated March 5, 2009, ("Office Action") and the Advisory Action dated August 10, 2009 ("Advisory Action"), pursuant to the O.G. Notice of July 12, 2005, Applicants respectfully request panel review of this application. This request is being filed in conjunction with a Notice of Appeal under 37 C.F.R. § 41.31, appropriate appeal fee payment, and a completed form PTO/SB/33. No amendments are filed with this request.

The arguments raised below are not comprehensive of Applicants' objections to the Final Office Action, but represent a summary of the prosecution history, which Applicants specifically incorporate by reference herein. Applicants reserve the right to raise additional arguments on appeal, including arguments are not raised here.

The Office rejects claims 1-3, 5, 8-12, 14, 22, 23, 30, 32, and 35 under 35 U.S.C. § 103(a) as allegedly "being unpatentable over" U.S. Patent No. 6,361,767 to Malle et al. ("Malle"). Claims 4, 6-7, 13, 15-21, 24-29, 31, and 33-34 are withdrawn from consideration.

In the Office Action, the Office states that "even though the [pending] claims recite 'activate hair by non-reducing activation', the same hair population is treated . . . using the same polymer (polyethyleneimine of example 8) and applying to the activated hair cosmetic active compound, which is claimed dye (col. 12, colorant graft step)." Office Action at 6. The Office alleges example 8 [i.e., method 8] of Malle "does not use any reducing agent." Advisory Action at 6. The Office then cites a section of U.S. Patent No. 5,523,080 at col. 5, ll. 20-48, asserting that it "teaches equation wherein the cosmetic active compound attaches to the substrate." *Id.* at 7. The Office concludes, apparently

based on that disclosure, that "[e]ven though [the '767] patent uses the word 'reducing' the method of example 8 does not use the conventional reducing agents described in the patent." Advisory Action at 9 (emphasis in original). The Office further alleges that "Example 1 of patent is drawn to fixing colorant on hair and therefore method 8 (step of a claim 1) and the description at col. 12 ll. 32-38 (step b of claim) teaches one of ordinary skill in the art would to use (sic) the same polyethyleneimine of example 8 for the cosmetic treatment of hair by producing activated hair by non-reducing activation of hair." *Id.* Applicants respectfully submit that this rejection is improper.

In an obviousness determination, the Office must consider the reference teachings as a whole, taking into consideration portions that would lead away from the claimed invention. See M.P.E.P. § 2141.02 (citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)). "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2d 1130, 1131 (Fed. Cir. 1994) (emphasis added).

As discussed above, the Office has acknowledged that the present claims recite "non-reducing activation." However, the Office continues to ignore the fact that Malle describes a method for treating hair keratin fibers by reducing the sulphur bonds to generate reactive sites. Rather, the Office continues to focus on the presence of the word "polyethyleneimine" in Malle method 8, instead of looking at the context the word is used in.

Method 8 of Malle only discloses polyethyleneimine in the context of "a branched polyethyleneiminepolymer carrying thiol functions" (col. 11 ll. 45-47), wherein

polyethyleneimine is not reacted with hair, and instead is reacted with a group containing a thiol function. (col. 11 ll. 50-62.) Malle explicitly teaches that it is the product of this reaction, "a branched polyethyleneimine polymer carrying thiol functions," (col. 11 ll. 45-47), which is applied to the hair in a "reduction step." *Id.* at col. 11 ll. 66-67, col. 12 1-2). This polyethyleneimine polymer having thiol functions of method 8 is a hyperbranched polymer carrying thiol functions, which, according to Malle itself, is a reducing agent. (col. 2 ll. 35-36 and 65-67.) Malle further states that, using method 8, "[s]urface reduction of the disulphide bonds of the hair keratin" was further demonstrated with a fluorescent probe. *Id.* at col. 12 ll. 5-8. Thus, the first step of method 8 is clearly a hair reduction step and a second step activates the hair with reactive orange. See *id.* at col. 2, ll. 65-67. This method is completely different from Applicant's disclosure.

Thus, Malle method 8 relied on by the Office discloses "a branched polyethyleneimine polymer carrying thiol functions." '767 col. 11, lines 45-46 (emphasis added). The presence of the thiol functions on the polyethyleneimine is further underscored by the thiol concentration disclosed "(thiol titre: 1220 meq/l)" in Malle. *Id.* at line 47. The thiol functions of Malle allow the compound to reduce the disulphide bonds on the keratin fibers, and moreover, Malle describes such reduction. See *id.* at lines 44-46 and 66-67 ("After this reduction step . . ."). Any skilled artisan knows that thiol functions are reducing agents. Thus, the Malle polymers are reducing agents and, in contrast, the polymers of the present application do not carry any thiol functions because the compound activates the hair without reducing the disulphide bonds of the hair. The Malle polymers do not teach or suggest non-reducing activation. In addition, the Office improperly states that Malle col. 7, ll. 40-45 "describes polyalkyleneimines as a nulofuge and this is the same elected species claimed in the instant application." Advisory Action at 4. However, the

nucleofuges of Malle correspond to compounds having a pyridine ring or a ring comprising two nitrogen atoms, and are not polyalkyleneimine compounds because they are not polymers. Moreover, Malle teaches this component only in addition to a reactive function which is a reducing group. See Malle at col. 7, ll 27-30. Contrary to the allegations of the Office, neither method 8 of Malle, nor any other disclosure in Malle teaches non-reducing activation of the hair.

The present claims recite "a non-reducing step of activation of the hair." This step necessitates a non-reducing component. Thiol functions would automatically reduce the disulphide bonds of the hair, which is outside the scope of the present claims. Therefore, the branched polyethyleneimine of Malle is structurally and functionally different from the polyethyleneimine used in the present application.

Rather than directing Applicants to specific portions of Malle that teach non-reducing activation of the hair, the Office has improperly and indiscriminately selected portions of Malle to identify components used in the claimed invention to reach an unsubstantiated conclusion that Malle discloses non-reducing activation of the hair. See *Ex parte Burgaud et al.*, Board of Patent Appeals and Interferences Decision for Appeal Docket No. 2009001991, 5 pages at pg 5. (a copy of which is available in the Image File Wrapper for Patent Application No. 10/611,968).

Malle teaches away from the present claims as it teaches reducing, whereas the present claims recite "non-reducing." Moreover, any proposal by the Office to modify Malle to obtain the present claims would cause Malle to become inoperable or destroy its intended function, thus precluding the requisite motivation from being present. See *In re Fritch*, 972 F.2d 1260, 1265-66, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). Indeed, since the compound used in Malle is a reducing agent, the hair would be activated by reducing

activation of the hair. In addition, Malle discloses a comparative study that demonstrates that the lock of hair, "which had not undergone prior reduction, had a very slight coloration which was only just discernible with the naked eye." Malle at col. 12, lines 42-53. Indeed, the entire purpose of Malle is to reduce the disulphide bonds of the keratin fibers in order to generate reactive sites on the surface to a depth of less than 10µm. See Malle Abstract. Therefore, in contrast to giving any suggestion to the person skilled in the art to use non-reducing components in order to activate the keratin fibers, a skilled artisan following the teachings of Malle would be led in a direction divergent from the path taken by the applicant.

For at least these reasons, Malle does not teach or suggest the present claims and, in fact, teaches away from the presently claimed invention. Thus, Malle cannot serve as a proper basis for a *prima facie* case of obviousness and the rejection should be withdrawn.

Accordingly, Applicants submit that the instant claims would not have been obvious to one of ordinary skill in the art in view of the cited art and thus request reconsideration and withdrawal of all the rejections. Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 4, 2009

By: Deborah M. Herzfeld
Deborah M. Herzfeld
Reg. No. 52,211
202-408-4368